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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/463,225	02/18/2000	ROBERT SCHWARTZ	ASCOP058USNP	6055

7590 07/05/2002

ATTEN: CLERENCE A. GREEN
PERMAN & GREEN, LLP
425 POST ROAD
FAIRFIELD, CT 06430

EXAMINER

VIG, NARESH

ART UNIT PAPER NUMBER

3629

DATE MAILED: 07/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/463,225

Applicant(s)

SCHWARTZ ET AL.

Examiner

Naresh Vig

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 - 4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 – 4 are rejected under 35 USC 103(a) as being unpatentable over Moore US Patent 5,917,925 in view of Gerzberg et al. US Patent 6,178,446.

Regarding claims 1 – 4, Moore disclose a system and method for marking mailpieces for postal fee and tracking purposes. A central control computer under the control of a postal service enables the system. Host computers under the control of customers and the postal service are used to control and audit the printing of indicia marks on mailpieces. Each host computer controls one or more indicia printers. Accounting/security systems are also provided within the system. The indicia printer marks the mail pieces with an encoded mark indicating first that the proper postal fee has been paid in order to "mail" the mail piece. Mailpieces can be scanned with remote field readers at any step in the mail distribution process, thereby providing information to

the postal service and to the customers. Real time analysis of the scanned indicia marks is used to reduce problems associated with counterfeiting of mailpiece indicia and mailpiece diversion. Information security is provided so that proprietary information of the postal service and the users of the system is maintained at all times. Moore system and method relates to an authenticating, anti-counterfeiting, and tracking system. Moore system marks the postage which is a substitute for a postage stamp or a prior art postage meter imprint as evidence of the fact that postage has been paid on mailpieces. The system is directed toward marking, tracking, and postal fee collection of mailpieces, and can be used to authenticate and track a wide variety of goods and articles of manufacture. The Moore system includes a control computer, one or more host computers (with one host computer generally being under the control of one customer) which cooperate with the control computer, a marking system, and a field reader system, which are all compatible and can be physically linked via data transmission links. Each host computer is isolated from the control computer by a postal security device. The control computer creates each indicium using data provided by the postal security device and the customer, supports communication with the vendor's infrastructure, provides customer interface, employs current postage rates, supports the use of standard mailing addresses, and maintains records regarding host system use. Each host computer stores the specific, selected information conveyed by the indicia mark which is 'customer specific', and directs the indicia printer to imprint the mark on the mail piece, and also receives and processes information from the reading system. Alternately, the indicia printer can imprint the mark on an item which is subsequently

attached permanently to the mailpiece, such as a gummed paper indicia mark akin to current postage stamps. Each host computer is connected via modem and through a postal security device to coordinate, receive, and respond to commands sent and received from the control computer, one or more indicia printer terminals, and one or more reading terminal.

In operation, the control computer contacts a host computer through a postal security device enigma card and enables a specific amount of postage fee, preferably equal to a prepaid amount. The host computer establishes an appropriate identifying message using clear text, such as the amount of "postage" to be imprinted as an indicium on a mailpiece based upon current postal rates, the weight of the piece, the destination of the piece, and the like. The host interfaces with an encryption unit which converts the clear text message into a two dimensional matrix symbol indicia. The host then downloads the digital symbol to the CPU controlling the indicia printer. The host preferably establishes marker start/stop serialized codes and specific times the indicia printer or printers can be in operation in order to discourage unauthorized usage. (see abstract; col.1, lines 14 – 19; col. 3, line 58 – col. 4, line 8; col. 5, lines 12 – 63; col. 13, line 11 – col. 14, line 4).

Moore does not disclose customer requesting a postal indicium. However, Moore discloses that controlled and specified amount of postage can be printed as indicia marks with final "mailing" address (specified by the customer) at a given mail room. Also, Host computers under the control of customers and the postal service are used to control and audit the printing of indicia marks on mailpieces. Gerzberg et al. discloses

system and method where a subscriber (customer) to a service will have the ability to order or request additional information on products that are being advertised (interactive commercials). A subscriber to the service will have the ability to order or request additional information on products that are being advertised. "Commercials are regularly displayed on a display device such as a video telephone or a television which is attached to a set top device. The subscriber to the service upon viewing a commercial on a display device can click on the advertisement to alert the advertiser that the customer is interested in the item that is being advertised. "Such interest may include, receiving an information pamphlet, receiving a coupon and ordering the product directly from the manufacturer or distributor through a requisition request". The actuation means can be a remote control device (or a touch screen) which sends signals to the set top device so as to create a subscriber request with respect to the commercial being displayed. Once a subscriber request has been created, the request is transmitted to the communication server, the communication server decodes the subscriber request message to determine the subscriber's identity and the action requested by the subscriber, a message is sent to the subscriber unit and then the requested information displayed on the display (the requested information can include coupons which can be either printed by a printer or stored on a smart card). (see abstract; col.2, lines 42 – 49; col. 8, line 59 – col. 9, line 26; col. 35, lines 35 – 58). Therefore, it is known at the time of applicant's invention to a person with ordinary skill in the art to modify Moore as taught by Gerzberg et al. and have the customer request the postal indicium to have the correct amount of postage applied to the mail to avoid return of mail due to insufficient

postage (for example, the mail can be international for which the postage rate is different).

In addition, Moore does not disclose providing the information over the fax machine. Gerzbert et al. discloses that the commercials are sent to the display device over the telephone network and are displayed on the display device. It is known at the time of applicants invention that fax machines have a printing mechanism to print the information received, and also, faxes can be received in the computer (fax modem in a computer device) and viewed on a computer display prior to printing. Therefore, it is obvious to a person with ordinary skill in the art implement a printing device like a fax machine to use the same printing device as a printer and a fax machine (for example, a multipurpose printer which has a scanner, copier, fax etc. capability).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

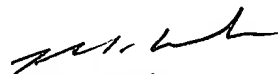
1. Kramer, US Patent 6,282,584.
2. Ryan Jr., US Patent 6,173,274.
3. Pierce et al., US Patent 6,151,591.
4. Bator et al., US Patent 5,826,246
5. Information on How Fax Machines Work.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naresh Vig whose telephone number is 703.305.3372. The examiner can normally be reached on M-F 7:30 - 5:00 (Alt Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703.308.2702. The fax phone numbers for the organization where this application or proceeding is assigned are 703.305.7687 for regular communications and 703.305.7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.305.3900.

June 26, 2002


John G. Weiss
Supervisory Patent Examiner
Group 3600